UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,181	12/31/2003	Kenichi K. Yabusaki	03-YAB-117	3401

23843 7590 10/05/2005

FOOTHILL LAW GROUP, LLP
3333 BOWERS AVE., SUITE 130
SANTA CLARA, CA 95054

EXAMINER	
PARSLEY, DAVID J	

ART UNIT	PAPER NUMBER
3643	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/751,181	YABUSAKI, KENICHI K.	
	Examiner	Art Unit	
	David J. Parsley	3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

Amendment

1. This office action is in response to applicant's amendment dated 6-22-05. Further, it is noted that the rejections set forth in the final rejection dated 8-29-05 have been removed in view of the new grounds of rejection set forth below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-5, 22-23, 26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 1,525,810 to Hill et al.

Referring to claims 1 and 26, Hill et al. discloses an instrument including, an elongate body – at d, having two straight parallel longitudinal sides – see figures 1-2, the body forming a curved groove between the longitudinal sides – see at the curved portion of item d or at the through hole at e, an end section – at a, the end section extending from the elongate body and tapering to a rounded point – see for example figures 1-2, and a plurality of tines – at b, emanating from a surface of the instrument – see figures 1-2, wherein at least one of the plurality

of tines emanates from the end section and is directed away from the rounded point and towards the elongate body – see for example figures 1-2, wherein at least one of the plurality of tines emanates from a location away from the sides and away from the end section – see for example figures 1-2. Hill et al. does not disclose the device is adapted to fit into the body of the bait fish and form a cavity when the instrument is inserted into the body rotated and removed. However, these limitations are intended use/functional limitations in an apparatus claim and therefore it is deemed that the device of Hill et al. is capable of performing this function in that as seen in figures 1-2, the device is of a size that it can be placed into the body of a fish and then moved/rotated in the body of the fish.

Referring to claim 4, Hill et al. further discloses the at least one tine that emanates form the end section includes a plurality of tines – at b – see for example figures 1-2.

Referring to claim 5, Hill et al. further discloses the plurality of tines emanate from the surface of the instrument at an angle in the range between about 15 degrees and about 45 degrees – see for example – at b in figures 1-6.

Referring to claim 22, Hill et al. further discloses the groove comprises a substantially continuously curved groove – see at e in figures 1-2.

Referring to claim 23, Hill et al. the sides comprise straight parallel longitudinal edges – see at d in figures 1-2, of the body and wherein none of the plurality of tines emanate from edges – see for example figures 1-2.

Referring to claim 28, Hill et al. further discloses all of the tines – at b, of the plurality of tines emanate form the end section – at a – see for example figures 1-2.

Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,704,769 to Hanechak et al.

Referring to claims 16-18, Hanechak et al. discloses a plug-cut bait made of a fish with its head cut off – see for example figures 1-9.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 7 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al. as applied to claims 1 or 26 above, and further in view of U.S. Patent No. 1,997,339 to Olson.

Referring to claims 2 and 29, Hill et al. does not disclose the instrument is made of steel. Olson does disclose the instrument is made of steel – see page 2 column 1 lines 60-69. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Hill et al. and add the instrument made of steel of Olson, so as to allow for the device to be made durable for repeated use.

Referring to claim 7, Hill et al. does not disclose the instrument is one integral piece. Olson does disclose the instrument is one integral piece – see for example figure 5. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Hill et al. and

add the instrument being one integral piece, so as to make the device easier to manufacture and more durable.

Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al. as applied to claim 1 above, and further in view of U.S. Patent No. 2,533,445 to Finney.

Referring to claim 3, Hill et al. does not disclose the instrument is made of stainless steel. Finney discloses the instrument is made of steel/stainless steel – see for example column 2 lines 8-14. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Hill et al. and add the instrument made of stainless steel of Finney, so as to allow for the device to be rust-resistant and more durable.

Referring to claim 6, Hill et al. does not disclose the end section includes a blade surface at the rounded point. Finney discloses the end section includes a blade surface – at 5, at the rounded point – see for example figures 1-2. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Hill et al. and add the blade surface at the end section of Finney, so as to facilitate cutting into an animal carcass.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al. as applied to claim 1 above. Hill et al. does not disclose the body is the bait fish herring. However, it would have been obvious to one of ordinary skill in the art to take the device of Hill et al. and add the body being the bait fish herring, so as to allow for the body to be prepared for further processing.

Claims 9-12, 14, 16, 19, 24-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finney in view of Hill et al. and U.S. Patent No. 4,704,769 to Hanechak et al.

Referring to claims 9, 16 and 27, Finney discloses a method including, inserting an entrails removal instrument into a body, the instrument comprising, an elongate body – at 4-5, having two straight parallel sides, the sides comprise straight parallel longitudinal edges of the body comprise straight parallel longitudinal edges of the body – see figures 1-3, the body forming a curved groove between the longitudinal sides – see at the joining of items 4 and 6 in figure 4, an end section – at 5, the end section extending from the elongate body and tapering to a rounded point – see for example figures 1-2, and a plurality of tines – at 6-8, emanating from a surface of the instrument, wherein at least one tine – at 8, of the plurality of tines emanates from the end section and is directed away from the rounded point and towards the elongate body – see for example figures 1-3, wherein the entrails removal instrument is adapted to fit into the body and form a hollow cavity when the instrument is inserted into the body, rotated and removed – see for example column 2 lines 8-55 and column 3 lines 1-24. Finney does not disclose at least one tine of the plurality of tines emanates from a location away from the sides and away from the end section. Hill et al. does disclose at least one tine – at b, of the plurality of tines emanates from a location away from the sides and away from the end section – at 12 – see for example figures1-2. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Finney and add the at least one tine emanating from a location away from the sides of the instrument of Hill et al., so as to allow for the device to easily penetrate the fish. Finney further does not disclose cutting the head off a bait fish with a knife while leaving the body and tail intact, inserting the entrails removal instrument into the fish body to a position forward of the tail and removing the viscera of the fish leaving the body and tail intact with a cavity. Hanechak et al. does disclose cutting the head off a bait fish with a knife while leaving the body and tail

intact – see for example figures 1-9, inserting the entrails removal instrument into the fish body – see figure 9, to a position forward of the tail – see figure 9, and removing the viscera of the fish leaving the body and tail intact with a cavity – see for example figures 1-9 and columns 3-4. Therefore it would have been obvious to one of ordinary skill in the art to take the method of Finney and add the cutting the head off the fish and then creating a cavity in the fish by removing the viscera of the fish of Hanechak et al., so as to allow for the fish to be prepared for eating or further processing.

Referring to clam 10, Finney as modified by Hill et al. and Hanechak et al. further discloses the entrails remover is inserted at least 2 inches into the fish body – see for example figures 1-3, column 2 lines 8-55 and column 3 lines 1-15 of Finney and figure 9 of Hanechak et al.

Referring to claim 11, Finney as modified by Hill et al. and Hanechak et al. further discloses moving the entrails removal instrument in a lateral motion – see for example column 2 lines 8-55 and column 3 lines 1-15 of Finney and columns 3-4 of Hanechak et al.

Referring to claim 12, Finney as modified by Hill et al. and Hanechak et al. does not disclose the act of rotating includes rotating at least 360 degrees. However, it would have been obvious to one of ordinary skill in the art to take the device of Finney as modified by Hill et al. and Hanechak et al. and add the act of rotating the instrument 360 degrees, so as to ensure that the entire viscera component can be contacted and removed by the device.

Referring to claim 14, Finney as modified by Hill et al. and Hanechak et al. does not disclose the body is the bait fish herring. However, it would have been obvious to one of ordinary skill in the art to take the device of Finney as modified by Hill et al. and Hanechak et al.

and add the body being the bait fish herring, so as to allow for the body to be prepared for further processing.

Referring to claim 19, Finney as modified by Hill et al. and Hanechak et al. does not disclose the bait fish is herring or anchovy or sardine or smelt. However, it would have been obvious to one of ordinary skill in the art to take the device of Finney as modified by Hill et al. and Hanechak et al. and add the bait fish being herring or anchovy or sardine or smelt, so as to allow for the body to be easily processed for further processing.

Referring to claim 24, Finney as modified by Hill et al. and Hanechak et al. further discloses the groove – see at item 4 of Finney and – at e of Hill et al., is a substantially continuously curved groove – see for example figure 1 of Finney and figures 1-2 of Olson.

Referring to claim 25, Finney as modified by Hill et al. and Hanechak et al. further discloses the sides comprise straight parallel longitudinal edges of the body – see for example at the edges of d in figures 1-2 of Hill et al., and wherein none of the plurality of tines emanate from the edges – see for example figures 1-2 of Hill et al.

Claims 13, 15-18 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finney as modified by Hill et al. and Hanechak et al. as applied to claim 12 above, and further in view of U.S. Patent No. 6,698,133 to Fricke.

Referring to claims 13 and 17, Finney as modified by Hill et al. and Hanechak et al. does not disclose inserting at least one fishing hook attached to a fishing line into the hollow cavity and pushing it out through the fish body to form a bait. Fricke et al. does disclose inserting at least one fishing hook attached to a fishing line into the hollow cavity and pushing it out through the fish body to form a bait – see for example figures 10-11. Therefore it would have been

obvious to one of ordinary skill in the art to take the device of Finney as modified by Hill et al. and Hanechak et al. and add the inserting of the fishhook into the fish body of Fricke et al., so as to allow for the device to be used to catch fish.

Referring to claims 15 and 18, Finney as modified by Hill et al., Hanechak et al. and Fricke et al. further discloses a plurality of fishing hooks – see for example column 7 lines 41-51 of Fricke et al.

Referring to claims 20-21, Finney as modified by Hill et al., Hanechak et al. and Fricke et al. does not disclose the bait fish is herring or anchovy or sardine or smelt. However, it would have been obvious to one of ordinary skill in the art to take the device of Finney as modified by Hill et al., Hanechak et al. and Fricke et al. and add the bait fish being herring or anchovy or sardine or smelt, so as to allow for the body to be easily processed for further processing.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanechak et al. as applied to claims 16-18 above. Hanechak et al. does not disclose the bait fish is herring or anchovy or sardine or smelt. However, it would have been obvious to one of ordinary skill in the art to take the device of Hanechak et al. and add the bait fish being herring or anchovy or sardine or smelt, so as to allow for the body to be easily processed for further processing.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al. as applied to claim 26 above, and further in view of Hanechak et al. Hill et al. does not disclose the instrument comprises plastic. Hanechak et al. does disclose the instrument comprises plastic – see for example column 2 lines 66-68 and column 3 lines 1-3. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Hill et al. and add the instrument made of Hanechak et al., so as to allow for the device lightweight and maintain durability.

Response to Arguments

4. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to handheld tools in general:

U.S. Pat. No. 1,667,544 to Frye – shows hand tool with tines

U.S. Pat. No. 2,218,072 to Runnels – shows hand tool with tines

U.S. Pat. No. 2,583,750 to Runnels – shows hand tool with tines

U.S. Pat. No. 5,766,193 to Millner – shows hand tool with tines

U.S. Pat. No. 2002/002375 to Legeai et al. – shows hand tool

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Parsley whose telephone number is (571) 272-6890. The examiner can normally be reached on Monday-Friday from 8am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DP

David Parsley
Patent Examiner
Art Unit 3643

PETER M. POON
SUPERVISORY PATENT EXAMINER

9/30/05